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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,331	01/25/2001	Takashi Suzuki	862.C2097	3930

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/768,331

Applicant(s)

SUZUKI ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 12/27/04.
- Claims 41-56 are newly added and pending in application; Claims 1-40 have been canceled.

### **Claim Rejections - 35 USC § 101**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 56 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 41-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al (US 5845008), and in view of Takeoka et al (US 6665082).

Regarding claim 41, Katoh discloses an apparatus (image processing device for copy machine, fig. 1, col. 11, lines 25-26) for processing image data to prevent the output of copy-prohibited image data (prevent copy-prohibited image from reproducing, col. 3, lines 40-52), said apparatus comprising:

- determination means (pattern detecting devices 1-3 for detecting and determining whether the document contains any confidential patterns, fig. 1, col. 5, lines 40-44) for testing the image data defining the image to determine whether the image data has characteristics of a copy-prohibited image (i.e. banknotes, abstract and col. 7, lines 21-28);
- dividing means (dividing into blocks, i.e. area 45 and 46 as shown in fig. 24, col. 21, lines 9-16) for dividing the image into a plurality of blocks (i.e. four blocks, fig. 36 & 38) for testing by said determination means, such that each block includes image data for an integer number of tiles (i.e. plurality of cells, fig. 13, col. 17, lines 31-55 and col. 21, lines 9-17); and
- control means (CPU 30, fig. 7, col. 19, lines 20-32) for generating a control signal to prevent (prohibit copy command will be issued, and the confidential items will not be copied, col. 5, lines 29-31) the output of image data for faithfully reproducing the image, in response to detection of image data having characteristics of a copy-prohibited image (document contains security mark 6, fig. 36) by said determination means, wherein said determination means is arranged to test the blocks generated by said dividing means to determine whether a block has characteristics of a copy-prohibited image.

Katoh explicitly teaches an image processing device as shown in fig. 1 & and fig. 27 for dividing image data into plurality of tiles in the length and width directions (fig. 24, col. 21, lines 9-16) and it can be incorporated into any devices such as printer, copy machine, a device to transmit communication, and etc., but fails to teach transferring image data defining an image in packets.

Takeoka, in the same field of endeavor for image processing apparatus for processing print data, teaches a printer controller 10 of fig. 1 for transmitting/transferring

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image data defining an image in packets (transferring image data in packets as shown in fig. 3 & figs. 5-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying an image processing device of Katoh to include a printer controller as taught by Takeoka to transmit image data in packets because of a following reason: (●) transmitting image data and/or print data in packets so that printer need not be provided with a memory having a large storage capacity of storing the quantity of image data representing one frame of an image. It provides the printer with a buffer memory small capacity, thereby lowering the cost of the printer (Takeoka, col. 2, lines 4-15 and col. 3, lines 1-5).

Therefore, it would have been obvious to combine Katoh with Takeoka to obtain the invention as specified in claim 41.

Regarding claim 42, Katoh further discloses an apparatus according to claim 41, wherein said apparatus further comprises image processing means (i.e. color processing circuit 56, fig. 27, col. 22, lines 4-16) responsive to the control signal to execute predetermined processing (i.e. making the entire screen go black and or signal prohibiting copy of confidential marks, col. 22, lines 4-16) of the image data determined by said determination means to have characteristics of a copy-prohibited image, wherein said control means is operable to generate the control signal to control said image processing means.

Regarding claim 43, Katoh further discloses an apparatus according to claim 42, wherein said image processing means is responsive to the control signal to change the density or brightness of the image data (varying confidential marks density and/or resolution, fig. 21, col. 20, lines 30-46).

Regarding claim 44, Katoh further discloses an apparatus according to claim 42, wherein said image processing means is responsive to the control signal to erase (col. 15, lines 25-28) the image data.

Regarding claim 45, Katoh further disclose an apparatus according to claim 41, wherein said determination means is operable to test the image data of a block (i.e. plurality of blocks figs. 36 & 38) to determine whether the image data has characteristics of a copy-prohibited image by testing the image data to determine whether it contains a digital watermark (watermark 6, fig. 36).

Regarding claim 46, Katoh further discloses an apparatus according to claim 41, wherein said apparatus further comprises thinning means for thinning the image data defining the image to generate a low-resolution image (reduce resolution, col. 4, lines 18-24 and col. 4, lines 60-67), and said dividing means is arranged to divide the low-resolution image to generate the plurality of blocks (partition into plurality of cells, col. 6, lines 20-25).

Regarding claim 47, Katoh further discloses an apparatus according to claim 46, wherein said determination means comprises means to test the blocks of low-resolution data to detect the position (position detecting unit 25 for detecting position coordinates of pattern detected, fig. 9, col. 7, lines 30-35 and col. 15, lines 55-56) of image data potentially having characteristics of a copy-prohibited image; extract (extract via extracting device 2, fig. 1) at least one block of original-resolution image data on the basis of the detected position, and test (test whether the documents contain any confidential marks, col. 8, lines 38-45) the extracted at least one block of original-resolution image data to determine whether the at least one block has characteristics of a copy-prohibited image.

Regarding claims 48-54: Claims 48-54 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 41-47; therefore, claims 48-54 are rejected for the same rejection rationale/basis as described in claims 41-47 above.

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Regarding claims 55-56: Claims 55-56 recite limitations that are similar and in the same scope of invention as to those in claims 48 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. memory 20, fig. 7 of Katoh) for storing computer programs, hence claims 55-56 would be rejected using the same rationale as in claims 48.

### *Response to Arguments*

Applicant's arguments with respect to *newly added claims 41-56 with added limitations* have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (●) U.S. 5621810 to Suzuki, discloses a method/apparatus for preventing forgery.
- (●) U.S. 6091844 to Fujii, discloses a method/apparatus for preventing forgery.
- (●) U.S. 5390003 to Yamaguchi, discloses a method/apparatus for preventing forgery.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER